

REMARKS

Claims 1 – 20 are pending in the above-captioned application. Claims 1-4 and 15-18 have been amended. Reconsideration of the rejections and objections is respectfully requested in view of the foregoing amendment and these remarks.

In the office action mailed July 2, 2004, the examiner:

- objected to the specification as containing informalities;
- rejected claim 18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- rejected claims 19 and 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0032217 to Huang (“the Huang publication”);
- rejected claims 1-6 and 8-18 under 35 U.S.C. § 103(a) as being unpatentable over the Huang publication in view of U.S. Patent No. 6,560,621 to Barile (“the Barile patent”);
- rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over the Huang publication and the Barile publication, and further in view of U.S. Patent No. 5,557,722 to DeRose (“the DeRose patent.”)

Objections

The examiner objected to the specification for containing the following informalities: on page 5, line 15, “prevent” should read “present;” on page 5, line 16, “[inventors?]” should be deleted. As shown on page 2 of this paper, the Specification has been amended to incorporate the examiner’s suggested corrections. Withdrawal of these objections is respectfully requested.

Rejections

35 U.S.C. § 101

The examiner rejected claim 18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the examiner stated that “the claimed invention is not tangibly

embodied in a computer readable/executable medium because a carrier wave does not constitute a tangible medium.” Applicants respectfully traverse.

Specifically, the recited “carrier wave” is a tangible medium. For example, the American Heritage Dictionary of the English Language, Fourth Edition, defines “carrier wave” as “an electromagnetic wave that can be modulated, as in frequency, amplitude, or phase, to transmit speech, music, images or other signals.” Thus, a “carrier wave” is a physical thing, and is therefore directed to statutory subject matter under 35 U.S.C. § 101. Moreover, the MPEP states that a signal claim directed to a practical application of electromagnetic energy is statutory. *See* MPEP §2106(IV)(b)(1)(c). Applicant, therefore, requests that the 35 U.S.C. § 101 rejection of claim 18 be withdrawn, and that the claim be allowed.

35 U.S.C. § 102(e)

The examiner rejected claims 19 and 20 under 35 U.S.C. § 102(e) as being anticipated by the Huang publication. Applicant respectfully traverses.

The Huang publication is not prior art to claim 19 of the present application under 35 U.S.C. § 102(e) because the portions of the disclosure upon which the examiner relies to reject claim 19 have an effective filing date of January 5, 2001, which is after the April 7, 2000 priority date of the present application. Specifically, Figure 1A, paragraphs 0038-0040, 00044 and 0056 of the Huang publication are not supported by the Huang provisional application. Rather, these paragraphs were added when the Huang non-provisional application was filed.

Applicant therefore requests that the 35 U.S.C. § 102(e) rejection of claim 19 be withdrawn, and that these claims be allowed. With respect to claim 20, which depends from claim 19 and also recites additional features of the invention, applicant requests that the 35 U.S.C. § 102(e) rejection of this claim be withdrawn and the claim allowed for the same reason as identified for claim 19.

35 U.S.C. § 103(a)

Claims 1-6 and 8-18

The examiner rejected claims 1-6 and 8-18 under 35 U.S.C. § 103(a) as being unpatentable over the Huang publication in view of the Barile patent.

Independent claim 1 has been amended to recite, *inter alia*:

“...receiving data from at least one application program; dividing the data into text data, and graphics data and context data; generating at least one file for storing at least a portion of the text data, graphics data or context data; wherein at least a portion of the context data is stored in XML format.”

Independent claim 15 has been amended to recite, *inter alia*:

“... at least one server computer includ[ing] at least one program stored therein, said program performing the following steps: receiving data from at least one application program; dividing the data into text data, graphics data and context data; and, generating at least one file for storing at least a portion of the text data, graphics data, or context data; wherein at least a portion of the context data is stored in XML format”

Independent claim 16 has been amended to recite, *inter alia*:

“... wherein the at least one server computer and the at least one user computer each include at least one program stored therein for allowing the at least one server computer and the at least one user computer to communicate information over the network, said programs operating in conjunction with one another to perform the following steps: receiving data from at least one application program; dividing the data into text data, graphics data and context data; and, generating at least one file for storing at least a portion of the text data, graphics data, or context data; wherein at least a portion of the context data is stored in XML format.”

Independent Claims 17 and 18 have been amended to recite, *inter alia*:

“... a first code segment for receiving data from at least one application program; a second code segment for dividing the data into text data, graphics data, and context data; and, a third code segment for generating at least one file for storing at least a portion of the text data, graphics data, or context data; wherein at least a portion of the context data is stored in XML format.”

Argument

Applicants believe that independent claims 1 and 15-18 are allowable because neither the portion of the Huang publication entitled to the provisional filing date of January 31, 2000, nor the Barile patent, either alone or in combination, disclose, teach or suggest “[R]eceiving data from at least one application program ... dividing the data into text data, graphics data, and context data ... [and] at least one file for storing at least a portion of the text data, graphics data, or context data; wherein at least a portion of the context data is stored in XML format,” as required by each claim.

Applicants note that although the Huang publication contains various references to the use of the XML format for structured documents, there is little support for these references in the provisional application (Ser. No. 60/179,330, filed January 31, 2000 (“the Huang provisional”). Specifically, the Huang provisional application only generally states that “[s]tructured documents such as XML and SGML have been promoted by many of the most influential software companies as the next step in the Web’s evolution,” (*see* the Huang provisional, page 2, lines 16-18), and “[a] structured document such as SGML and XML starts with document type definitions (DTD),” (*see id.*, page 11, lines 1-2). The Huang publication has a filing date of January 5, 2001, which is *after* the priority date of April 7, 2000 for the present application.

Although the Huang provisional generally notes the existence of XML as used in the creation of structured documents, it does not disclose “[R]eceiving data from at least one application program ... dividing the data into text data, graphics data, and context data ... [and] at least one file for storing at least a portion of the text data, graphics data, or context data; wherein at least a portion of the context data is stored in XML format,” as recited in independent claims 1 and 15-18.

The Barile patent does not remedy this deficiency, because it discloses converting files directly to HTML, and does not disclose storing document context data in XML format. (See Barile patent, col. 4, lines 58-60, col. 5, lines 1-21).

Applicant therefore requests that the 35 U.S.C. § 103(a) rejections of independent claims 1 and 15-18 be withdrawn, and that these claims be allowed. With respect to claims 2-14, which

depend from claim 1 and which recites additional features of the invention, applicant requests that the 35 U.S.C. § 103(a) rejection of these claims be withdrawn and the claims be allowed for the same reason as identified for claim 1.

Claim 7

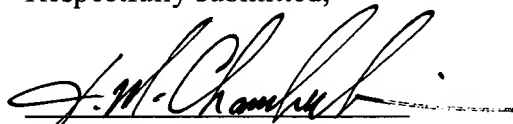
The examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over the Huang publication and the Barile patent, and further in view of the DeRose patent. Claim 7 depends from independent claim 1, and thus contains all of the limitations of that claim. Like the Barile patent, the DeRose patent does not disclose storing document context data in XML format. Thus, applicant considers that claim 7 is allowable for the same reasons as identified above in relation to claim 1, and thus request that the 35 U.S.C. § 103(a) rejection of claim 7 be withdrawn and that the claim be allowed.

In view of the foregoing amendment and remarks, it is respectfully submitted that claims 1 - 20 are in condition for allowance. Prompt favorable action thereon is respectfully solicited.

A fee of \$55.00 is believed to be due with this response. Please charge this, and any additional required fees, to deposit account **50-2061**.

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Respectfully submitted,



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